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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/536,822

10/18/2005

Mitsuharu Hirai

0666.2510000/TGD/AFK

6627

26111 7590 01/13/2009
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EXAMINER

BERTAGNA, ANGELA MARIE

ART UNIT

PAPER NUMBER

1637

MAIL DATE

DELIVERY MODE

01/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/536,822</p>	<p>Applicant(s) HIRAI ET AL.</p>	
	<p>Examiner ANGELA BERTAGNA</p>	<p>Art Unit 1637</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1-4 and 8-10.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Kenneth R Horlick/
Primary Examiner, Art Unit 1637

Continuation of 3. New claim 11 depends from independent claim 2 and requires that the cationic surfactant adsorbs to an impurity and alters its electric charge. Adsorption of an impurity by a cationic surfactant has only been previously considered in the context of claims 3 and 4, which do not depend from claim 2. These claims require the use of a cationic surfactant together with a nonionic surfactant. Since the limitations recited in newly presented claim 11 have not been previously considered in the context of independent claim 2, the proposed amendment raises new issues requiring further consideration and/or search. Accordingly, the proposed amendment has not been entered.

Continuation of 11. Applicant's arguments, see pages 7-9, filed on December 22, 2008 are directed to the claims as amended. Since the proposed amendment was not entered, these arguments are moot.

Applicant's arguments, see pages 9-10, are not directed to the claims as amended. These arguments have been fully considered, but they were not persuasive.

Applicant argues that application of the teachings of Helenius to the method of Kreader would render the method of Kreader unsuitable for its intended purpose since the method of Kreader is performed at acidic pH, whereas the method of Helenius is performed at basic pH (see pages 9-10). This argument was not persuasive, because as discussed above, application of the teachings of Helenius regarding mixtures of surfactants to the method of Kreader would result in the same end result, namely separation of contaminating charged proteins from nucleic acids in a sample. Application of the teachings of Helenius to the method of Kreader also would not change the principle of operation of the method taught by Kreader. The method of Kreader is directed to removal of impurities from nucleic acids in a sample by altering the electrophoretic mobility of the impurity (paragraphs 17-19 and 27-31). Application of the teachings of Helenius regarding the use of a mixture of surfactants to alter electrophoretic mobility of proteins, which Kreader taught can contaminate nucleic acid samples, would not change the principle of operation of the Kreader method, since using the mixture of surfactants taught by Helenius would serve the same purpose as the low pH condition taught by Kreader, namely alteration of the electrophoretic charge of an impurity in a sample to permit separation of the impurity from nucleic acids.

Since Applicant's arguments are either moot or unpersuasive, claims 1-4 and 8-10 remain rejected for the reasons set forth in the final rejection mailed on September 26, 2008.